

REMARKS/ARGUMENTS

Status of the claims

Upon entry of the present amendment, claims 22-41 are pending. Claims 22, 24, 25, 29, 32 and 35 are amended without prejudice to future prosecution. Claims 40 and 41 are withdrawn from further consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention. Paragraph 142 was amended to correct a typographical error in the ratio between enantiomers identified for the salt as "1/3". One of ordinary skill in the art would recognize the ratio between enantiomers in the salt is inversely proportional to the ratio between free enantiomers in solution and, accordingly, this ratio is amended to "3/1". This ratio comports with the ratio as presented elsewhere in the specification, particularly with the Examples and Figures. The amendment of the term "solution" in the claims to the term "crystallization solution mixture" finds support in paragraph 73 of the specification and the amendment of the term "activated α -(phenoxy)phenyl-acetic acid" to "activated α -(phenoxy)phenyl-acetic acid derivative" finds support in paragraph 81 of the specification. Support for inclusion of the term "at most" in claim 22 may be found in the description at in paragraph 142 which describes the 1:3 ratio as the approximate endpoint for the selectivity of the method of the present invention. Accordingly, the Applicants believe that these amendments add no new matter.

Applicants acknowledge, with appreciation, the Patent Office's indication that claims 22, 23 and 27-39 would be allowable if the 35 U.S.C. 112, second paragraph were overcome. Claims 22, 23 and 27 are rejected under 35 U.S.C. §102 for alleged lack of novelty over Luskey *et al.* U.S. Patent No. 6,262,118. Claims 28-30 are rejected under 35 U.S.C. §103 for alleged obviousness in view of Luskey *et al.*.

Objection to the Abstract

The abstract was objected to for not corresponding to the currently claimed subject matter. In the interest of advancing prosecution, Applicants have amended the abstract in an effort to obviate this objection. In view of the above amendment and remarks, Applicants respectfully request that this objection be withdrawn.

Rejection of claims 22-39 under 35 U.S.C. § 112, second paragraph

Claim 22 stands rejected because the Patent Office alleges that the term "racemic mixture" lacks antecedent basis. In the interest of expediting prosecution, Applicant has replaced this term with the term "enantiomeric mixture" which has antecedent basis.

Claim 24 stands rejected because the Patent Office alleges that the recitation of the ratio of the amount of the first free enantiomer to the amount of the free second enantiomer in the solution is "about 1 to 3" is indefinite. The Applicant believes that this recitation is adequately understood by one of ordinary skill in the art, but has replaced this term with the term "at most about 1:3" in the interest of expediting prosecution.

Claim 24 also stands rejected because the Patent Office alleges that the recitations "first enantiomer" and "second enantiomer" are indefinite because they are not defined with respect to which is concentrated. The Applicants respectfully traverse this rejection. The specification provides a both general and specific descriptions of the resolution of one of two enantiomers on pages 5-13. Either enantiomer can be separated by this method as would be understood to one of ordinary skill in the art. Applicant submits that further description than that provided in claim 24 is not needed by one of ordinary skill in the art to recognize that the desired, first enantiomer is being concentrated in the salt while the second enantiomer is being concentrated in solution.

Claim 25 stands rejected as allegedly being indefinite because the Patent Office alleges that the sequence of events is not possible. In the interest of expediting prosecution, Applicant has added term with the term "subsequently" to step (ii).

In view of the above amendments and remarks, Applicants respectfully request that these rejections be withdrawn.

Rejection of claims 22, 23 and 27-30 variously under 35 U.S.C. 102 or 103.

The Patent Office rejected claims 22, 23 and 27 as allegedly being anticipated by Luskey *et al.* (U.S. 6,262,118) and claims 29-30 as allegedly being obvious in view Luskey *et al.* The Patent Office acknowledges that the method of the present invention wherein the total amount of enantiomerically enriched chiral amine compound used is less than 0.5 molar

equivalents with respect to the α -(phenoxy)phenylacetic acid compound is not disclosed, taught or suggested by the cited art (Office Action, page 8). The Applicant appreciates the Patent Office's identification of allowable subject matter provided by the Examiner and have included this recitation in claim 22.

In view of the above amendments and remarks, Applicants respectfully request that these rejections be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for substantive review on their merits. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5014.

Respectfully submitted,



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